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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,248	07/31/2001	John Holden Bickford	RSW920010143US1	2799

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IBM CORPORATION  
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EXAMINER
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PYZOCHA, MICHAEL J

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/919,248	BICKFORD ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Michael Pyzocha	2137	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 July 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 1-14 are pending.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Fischer (US 2002/0010638).

As per claims 1-2, Fischer discloses an authentication method for electronic mail, comprising the steps of: preparing electronic mail for sending from an originator to a recipient; including in subject line of the electronic mail an authentication key associated with the originator and known to the recipient; and sending the electronic mail from the originator to the recipient (see paragraph 25).

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***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer and further in view of Bando et al (US 6405244).

As per claim 3, Fischer discloses an authentication method for electronic mail, comprising the steps of: preparing electronic mail for sending from an originator to a recipient; including the authentication key in an open field of the electronic mail; and sending the electronic mail from the originator to the recipient.

Fischer fails to disclose reading from a memory an authentication key associated with the originator.

However, Bando et al teaches reading authentication information associated with the originator (see column 5 line 54 through column 6 line 6).

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At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Bando et al's method of reading authentication information in the email authentication method of Fischer.

Motivation to do so would have been to decide that falsification or alteration has not been performed (see Bando et al column 6 lines 1-6).

As per claim 4, the modified Fischer and Bando et al system discloses the open field is the subject line (see Fischer paragraph 25).

As per claim 5, the modified Fischer and Bando et al system discloses the authentication key associated with the originator is further associated with the recipient (see Fischer paragraph 25).

6. Claims 6- are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Fischer and Bando et al system and further in view of Davis et al (US 5937160).

As per claim 6, the modified Fischer and Bando et al system discloses an authentication method for electronic mail, comprising the steps of: receiving electronic mail from an originator; when an authentication key is present, determining whether the authentication key is associated with the originator; and rejecting the electronic mail when the

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authentication key is not associated with the originator (see Fischer and Bando et al as applied to above claims).

The modified Fischer and Bando et al system fails to disclose determining whether an authentication key is present in an open field of the electronic mail.

However, Davis et al teaches determining whether a type of information is present in an open field of the electronic mail (see column 11 lines 25-42).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Davis et al's method of determining the presence of information in the subject field to determine if the authentication information of the modified Fischer and Bando et al system is present.

Motivation to do so would have been to allow for different actions to occur based on the information in the subject (see Davis et al column 11 lines 25-42).

As per claim 7, the modified Fischer, Bando et al and Davis et al system discloses the open field is the subject line (see Fischer paragraph 25).

As per claim 12, the modified Fischer, Bando et al, and Davis et al system discloses claimed material as applied to claims 1 and 6.

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7. Claims 8-11, 13-14 rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Fischer, Bando et al, and Davis et al system and further in view of MSA (post by Arthur Urbanowicz).

As per claim 8, the modified Fischer, Bando et al, and Davis et al system discloses an authentication method for electronic mail, comprising the steps of: receiving electronic mail from an originator; determining whether an authentication key is present; and rejecting the electronic mail when the authentication key is not present (see rejection of claim 12).

The modified Fischer, Bando et al and Davis et al system fails to disclose determining whether an authentication key is expected to be present; and when it is authenticate the user.

However, MSA discloses such a conditional authentication method (see page 1).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use MSA's conditional authentication method in the modified email authentication system of Fischer, Bando et al and Davis et al.

Motivation to do so would have been require un-trusted users to be authenticated (see MSA page 1).

As per claim 9, the modified Fischer, Bando et al, Davis et al and MSA system discloses an authentication method for

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electronic mail, comprising the steps of: receiving electronic mail from an originator; determining whether an authentication key is expected to be present in an open field of the electronic mail; when an authentication key is expected to be present, determining whether the authentication key is present; when the authentication key is not present, rejecting the electronic mail; and when the authentication key is present, determining whether the authentication key is associated with the originator, accepting the electronic mail when the authentication key is associated with the originator, and rejecting the electronic mail when the authentication key is not associated with the originator (MSA applied to the rejection of claims 6 and 8).

As per claim 10, the modified Fischer, Bando et al, Davis et al and MSA system discloses the step of determining whether an authentication key is expected to be present in an open field of the electronic mail further includes the step of reading a memory at an address that is dependent upon a source identifier that identifies the originator (see MSA where the trusted server name is inherently stored in memory).

As per claim 11, the modified Fischer, Bando et al, Davis et al and MSA system discloses the step of determining whether the authentication key is associated with the originator further



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includes the step of reading a memory at an address that is dependent upon a source identifier that identifies the originator (see Bando et al column 5 line 54 through column 6 line 6).

As per claim 13, the modified Fischer, Bando et al, Davis et al and MSA system discloses an authentication method for electronic mail, comprising the steps of: preparing electronic mail for sending from an originator to a recipient; sending the electronic mail from the originator to the recipient; receiving the electronic mail from the originator; determining whether an authentication key is expected to be present in an open field of the electronic mail; when an authentication key is expected to be present, determining whether the authentication key is present; and rejecting the electronic mail when the authentication key is not present in the open field of the electronic mail (see rejection of claims 12 and 9).

As per claim 14, the modified Fischer, Bando et al, Davis et al and MSA system discloses an authentication method for electronic mail having a subject line, comprising the steps of; preparing electronic mail for sending from an originator with a source identifier to a recipient with a destination identifier; sending the electronic mail from the originator to the recipient; receiving the electronic mail from the originator;

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determining whether an authentication key is expected to be present in an open field of the electronic mail; when an authentication key is expected to be present, determining whether the authentication key is present; when the authentication key is present, determining whether the authentication key is associated with the originator and further associated with the recipient; accepting the electronic mail when the authentication key is determined to be associated with the originator and the recipient; rejecting the electronic mail when the authentication key is determined not to be associated with the originator and further associated with the recipient; and, when the authentication key is not present, rejecting the electronic mail (see rejection of above claims where it is inherent that every email has a source and destination identifier).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Chan et al (US 6505300) discloses a method for processing different trust levels.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael

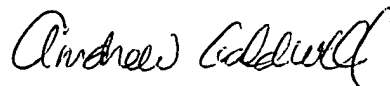
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Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJP



**ANDREW CALDWELL**  
**SUPERVISORY PATENT EXAMINER**